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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/617,265	03/18/96	HOLLANDER	M OE003USQ1

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EXAMINER

GUTIERREZ, D
ART UNIT PAPER NUMBER

3108

DATE MAILED: 02/18/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 11/19/96 & 2/14/97
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-24 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) 16-24 is/are allowed.
- ☐ Claim(s) 1-7, 9-15 is/are rejected.
- ☐ Claim(s) 8 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☒ The proposed drawing correction, filed on 11/19/96 is ☒ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper.No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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1. Claims 1, 4-7, 9-15 are finally rejected under the judicially created doctrine of non-statutory double patenting as being unpatentable over claims 9-14 of U.S. Patent No. 5,368,392. The now claimed subject matter is described within the disclosure and encompassed within the scope of the claims of Applicant's U.S. Patent No. 5,368,392, and therefore, a claim for the now claimed subject matter could have been presented therein.

See particularly the description of Figs. 3 and 6 which discloses the use of a rotating laser; the description of Fig. 8 which discloses the use of a motor to rotate the laser beam, thus "adjusting" or "calibrating" the position of the laser beam; the description of Fig. 7, particularly, column 7, lines 3-5 which discloses the use of two fibers, each carrying a laser beam and positioned 180 degrees apart; and the description in column 3, lines 45-47 which suggests the use of a dedicated laser for each laser beam used to outline the energy zone, i.e., two lasers.

2. The non-statutory type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term. See *In re Schneller*, 158 USPQ 210 (CCPA 1968). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

3. Claims 1-3 are finally rejected under the judicially

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created doctrine of obviousness-type double patenting as being unpatentable over claims 9-14 of U.S. Patent No. 5,368,392.

Claims 9-14 of the US Patent claim a laser sighting device including means for visibly positioning the laser beam about the energy zone to be measured. Claims 9-14 claim all the limitations stated in claims 1-3 of this application with the exception of how the laser sighting device is attached to the radiometer. However, how the laser sighting device is attached to the radiometer, i.e., removably mounted or integrally formed, absent any criticality, is only considered to be a choice of engineering skill or design since neither non-obvious nor unexpected results will be obtained as long as the laser sighting device is attached to the radiometer. Furthermore, the claims in the U.S. Patent indicate that the laser sighting device is used in conjunction with a radiometer, which implies to a person having ordinary skill in the art, that the radiometer and sighting device must be attached to each other in some way. Moreover, with respect to claim 3, the term "integrally" is sufficiently broad to embrace constructions united by such means as fastening and welding. See In re Hotte, 177 USPQ 326, 328 (CCPA 1973).

4. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct

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from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

5. The Terminal Disclaimer filed on November 19, 1996, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. 5,368,392 has been reviewed and is NOT a

6. The Terminal Disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because the disclaimer fee of \$55.00 in accordance with 37 CFR 1.20(d) has not been submitted, nor is there any authorization in the application file to charge a Deposit Account.

7. The Terminal Disclaimer does not comply with 37 CFR 3.73(b) because there is no documentary evidence of a chain of title from the original inventor(s) to the assignee, nor is it specified (by reel and frame number) where such documentary evidence is recorded in the Office (37 CFR 3.73(b)).

8. The Terminal Disclaimer does not comply with 37 CFR 3.73(b) because there is no statement by the assignee specifying that the evidentiary documents have been reviewed and

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certifying that, to the best of the assignee's knowledge and belief, title is in the assignee seeking to take action (37 CFR 3.73(b)).

9. Claims 1-7 and 9-15 would be allowable if a proper terminal disclaimer is timely filed.

10. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 16-24 are allowed over the prior art of record.

12. Applicant's arguments filed November 19, 1996 have been fully considered.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory

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period for response expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Gutierrez whose telephone number is (703) 308-3875.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.



DIEGO F.F. GUTIERREZ
PRIMARY EXAMINER
GROUP ART UNIT 3108

DG
February 14, 1997